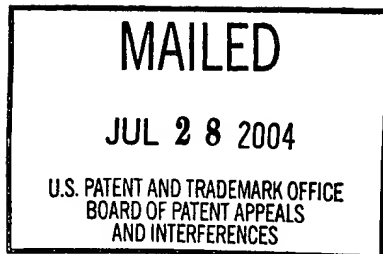


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MICHEL LUSSIER

Appeal No. 2004-1280
Application No. 09/630,938

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 4-23, 26-31 and 35-39, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a structural chassis for an article of footwear, such as a football or soccer shoe, the chassis being "constructed to provide the

desirable properties of comfort, flexibility, and effective power transfer without the difficulty and expense of trying to provide these properties in a traditionally molded outsole" (specification, page 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Thomas	444,735	Jan. 13, 1891
Trolle	1,141,889	Jun. 1, 1915
Lorenzi et al. (Lorenzi)	1,684,676	Sep. 18, 1928
Cameron	3,739,497	Jun. 19, 1973
Crowley	4,393,604	Jul. 19, 1983
Tong et al. (Tong)	5,185,943	Feb. 16, 1993
Barre et al. (Barre)	5,473,827	Dec. 12, 1995
Barma et al. (Barma)	5,546,680	Aug. 20, 1996
Giese et al. (Giese)	5,572,805	Nov. 12, 1996
Kendall	5,713,143	Feb. 3, 1998
Brown	D446,917	Aug. 28, 2001

(filed Apr. 26, 2000)

The following rejections are before us for review.

Claims 26, 29 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Crowley.

Claims 1, 4-9, 19-21, 26-29 and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tong.

Claims 26 and 29-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trolle in view of Barma.

Claims 1, 4, 6-10, 19 and 26-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lorenzi.

Claims 1, 5, 6, 8-10, 12-23 and 39 stand rejected under 35 U.S.C. § as being unpatentable over Giese in view of Tong or in view of Brown and Thomas.

Claim 11 stands rejected under 35 U.S.C. § as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Kendall.

Claims 26-30 and 35-38 stand rejected under 35 U.S.C. § as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Crowley.

Claims 30 and 31 stand rejected under 35 U.S.C. § as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Crowley and Cameron or Barre.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 26) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 25 and 27) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claims 26, 29 and 30 as being anticipated by Crowley. Crowley discloses a molded outsole 10 including an outsole member 12 provided with large studs or cleats 14, 16, 18, 20, 22, 24, 26 and smaller studs or cleats 28, 30, 32, 34 which may be integrally molded of a plastic material such as polyurethane or polyvinylchloride. Appellant's only argument against this rejection is that Crowley's outsole is distinguishable from appellant's "chassis" in that appellant's claimed apparatus is distinct from and in addition to any outsole (brief, page 11). As described in appellant's specification (page 11), an embodiment of the invention replaces a conventional outsole with a soft outsole and adds the chassis to achieve the required stiffness.

In proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to

be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We appreciate that the specification of the present application discloses athletic shoes wherein the traditional hard plastic outsole is replaced with a soft outsole and a hard chassis or with an integrally formed chassis and skin construct (specification, page 2). Claims 26, 29 and 30, however, merely recite an article of footwear including a sole with at least one cleat, the sole comprising a chassis. These claims do not recite an outsole structure in addition to the chassis and we, like the examiner, see no recited structure in claim 26 which distinguishes the claimed footwear from Crowley's athletic shoe or the recited "chassis"¹ from Crowley's outsole member 12. Having found appellant's only argument with respect to the rejection of claims 26, 29 and 30 unpersuasive, we shall sustain this rejection.

We turn next to the rejection of claims 1, 4-9, 19-21, 26-29 and 35 as being anticipated by Tong. Tong, in the embodiment illustrated in Figures 16 and 17, discloses an athletic shoe having an insert member 120 extending from the heel portion to the toe portion of the shoe and having rearfoot, midfoot and forefoot portions. The

¹ The term "chassis" is generally understood to be "a frame" or "assembled frame and parts" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)) and we find no definition in appellant's specification which compels or even suggests a different interpretation of this term.

extending portion 124 of Tong's insert member extends into the forefoot region and is formed by a plurality of fingers 122, as best seen in Figure 16. The extending portion "is made to have an undulating or sinusoidal shape in cross section" (column 9, lines 27-29) so that the extending portion acts as a spring to return energy to the user. This occurs because forces acting perpendicular to sole 118 deflect the extending portion and tend to decrease the size of the peaks and valleys when a load is placed on the extending portion.

Each of appellant's claims recites a "generally planar" chassis. To understand the meaning of "generally planar," we look to appellant's specification, which informs us on page 8, in lines 1-5, that

[t]he chassis 2 is generally planar; however, the chassis 2 may be contoured to better conform to the shape of a foot. For example, Figs. 1B-1D show the chassis 2 offset in an arch region 17 to support a wearer's arch. The chassis 2 may also have a three-dimensional shape. Examples of three-dimensional elements are side elements 128 and lugs or roots 130, described further in Figs. 2A-2G.

It is apparent from this disclosure that the chassis can include substantial non-planar contours and protruding elements and still be considered "generally planar" as that terminology is used by appellant. With this in mind, we do not agree with appellant that the undulations of Tong's extending portion render Tong's insert member 120 non-responsive to the "generally planar" limitation of appellant's claims. This being

appellant's only argument with respect to claims 1, 6-9, 19-21, 26-29 and 35, we shall sustain the rejection with respect to these claims.

With respect to claim 4, to the extent that appellant is arguing on page 14 of the brief that Tong lacks three elongated elements in the forefoot portion of the chassis, we do not find this argument persuasive. The four fingers 122 of Tong's insert member 120 clearly respond to this limitation. The rejection is sustained with respect to this claim as well.

We shall not, however, sustain the rejection of claim 5 as being anticipated by Tong. Simply stated, the examiner's position that the valleys 130 of the undulations of Tong's extending portion 124 respond to the "at least one indentation along a width of the chassis" (answer, page 10) is untenable.

The examiner has rejected claims 26 and 29-31 as being unpatentable over Trolle in view of Barma. Trolle discloses footwear, such as shoes or boots intended for use by persons "who require footwear which will withstand rough usage and protect the feet against moisture, cold, briars, rocks, stones and their effects" (page 1, lines 52-55). The shoe comprises a "shoe bottom" or sole A connected to an upper B. According to Trolle, the bottom is preferably made of metal and the upper is preferably made of leather, but "any other suitable materials may be employed for these parts" (page 2, lines 13-15). The examiner has determined that either ground engaging member C or

ground engaging member D responds structurally to the “at least one cleat” recited in claim 26 and appellant does not take issue with that determination. The examiner concedes that Trolle’s article of footwear differs from the article of claim 26 in that the sole does not comprise a polymeric chassis. Relying on the teachings of Barma of the interchangeability of metal and plastic, such as PVC or fiberglass, for use in protective inserts in the soles of safety boots worn in hazardous environments, however, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to use polymeric materials for the chassis (bottom A) of Trolle’s article of footwear in light of their known use and suitability as protective materials in soles of footwear as evidenced by Barma. We agree with the examiner. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 199, 125 USPQ 416, 418 (CCPA 1960).

Appellant argues that Trolle’s shoe bottom A is actually an outsole and thus is not a “chassis” as called for in appellant’s claim 26. We find this argument unpersuasive for the reason discussed above with regard to the rejection of claims 26, 29 and 30 as being anticipated by Crowley.

Appellant also argues that Barma teaches away from Trolle because Barma relies on protective plates added to a rubber boot, whereas Trolle employs a metal

shoe sole to accomplish the same function. Consequently, according to appellant, “there is no need to employ the [Barma] protective plates in a shoe having a metal sole that by itself protects the wearer’s foot” (brief, page 24). This argument does not appear to address the modification proposed by the examiner. The examiner has not proposed adding protective inserts to Trolle’s shoe bottom but, rather, making Trolle’s shoe bottom of rigid plastic rather than metal. As discussed above, we agree with the examiner that Barma’s teaching of the interchangeability of metal and plastic in footwear soles to protect the wearer’s foot provides ample motivation for the modification proposed by the examiner.

Appellant also appears to be arguing on pages 24 and 25 of the brief that Trolle and Barma are non-analogous art to appellant’s invention, because Trolle and Barma are directed to safety footwear while appellant’s invention is directed to athletic shoes. For the following reason, we do not find this argument persuasive.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315

(Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

In this instance, appellant's specification informs us on page 1 that appellant's invention relates to the construction of a structural chassis "for an article of footwear, such as a football shoe or a soccer shoe." Moreover, claim 26 is directed broadly to an "article of footwear," not specifically to an athletic shoe. Trolle and Barma are also directed to articles of footwear and thus are from the same field of endeavor as is appellant's invention. We therefore conclude that Trolle and Barma are analogous art to appellant's invention.

For the foregoing reasons, we do not find any of appellant's arguments with regard to the rejection of claim 26 as being unpatentable over Trolle in view of Barma persuasive. It follows that we shall sustain the rejection of claim 26, as well as dependent claims 29-31 which appellant has not separately argued apart from claim 26 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

We shall not sustain the rejection of claims 1, 4, 6-10 and 19 as being unpatentable over Lorenzi. In short, Lorenzi's stiffening plate 4 cannot reasonably be considered to comprise "a plurality of elongated elements defining at least one space therebetween extending from a forwardmost extent of the forefoot portion and terminating in the midfoot portion" as recited in claim 1. While the central tongue 5 and

the arcuate peripheral portions of the stiffening plate 4 in the forefoot region may be considered to be a plurality of elongated elements defining two spaces therebetween, neither of those spaces extends from a forwardmost extent of the forefoot portion as called for in appellant's claim 1, as well as claims 4, 6-10 and 19 depending therefrom. Thus, even if Lorenzi's metal stiffening plate were modified so as to be formed of polymeric material as proposed by the examiner on page 5 of the answer, this would not result in appellant's claimed invention.

With regard to claim 26, which merely calls for an article of footwear including a sole with at least one cleat, the sole comprising a generally planar polymeric chassis extending substantially along an entire length of a heel portion and toe portion of the article of footwear, appellant's only arguments are that Lorenzi is non-analogous art to appellant's invention and that Lorenzi's stiffening plate is not "generally planar" as called for in the claim. With respect to the first argument, inasmuch as both appellant's invention and Lorenzi are directed to footwear and are thus within the same field of endeavor, Lorenzi's boot is analogous art to appellant's invention. As to the second argument, for the reasons discussed above, the terminology "generally planar" is interpreted, in light of the specification, as encompassing structures having substantial non-planar contours and protruding elements. Lorenzi's stiffening plate is thus considered "generally planar" as used in appellant's claim 26. Finding neither of

appellant's arguments persuasive, we shall sustain the rejection of claim 26 as being unpatentable over Lorenzi.

Claim 27 depends from claim 26 and further recites at least one elongated element extending toward a toe portion from the midfoot portion. Lorenzi's central tongue 5 appears to meet this additional limitation. The rejection of claim 27 as being unpatentable over Lorenzi is thus sustained.

As to claim 29, which depends from claim 26 and further recites that the sole is an outsole, inasmuch as the stiffening plate 4 of Lorenzi appears to be part of an outsole, Lorenzi meets this additional limitation. The rejection of claim 29 as being unpatentable over Lorenzi is thus also sustained.

Claim 28 depends from claim 26 and further recites that the chassis comprises a plurality of elongated elements extending generally from a heel portion to a toe portion. While it is true that Lorenzi's stiffening plate 4 is a one-piece unitary structure, this structure includes medial and lateral peripheral portions and a central tongue, which may reasonably be considered to be elongated elements, with the medial and lateral portions having midfoot, forefoot and rearfoot portions and extending from a heel portion to a toe portion. We note that appellant's plurality of finger-shaped elements in the embodiments of Figures 1 and 2, for example, are part of a unitary structure but are still defined by appellant as elongated elements or fingers. With that in mind, we find

nothing in claim 28 which precludes the elongated elements being connected as part of a unitary structure. The rejection of claim 28 as being unpatentable over Lorenzi is sustained.

We shall not sustain the rejection of claims 1, 5, 6, 8-10, 12-23 and 39 as being unpatentable over Giese in view of Tong or in view of Brown and Thomas. The stabilizer 19 of the embodiments of Figures 111-116 of Giese starts at the back of the heel and extends to just short of the ball of the foot by design so that it stiffens the rear of the bottom but permits it to flex at the ball of the foot (see column 10, lines 59-62, which discusses the basic internal comfort stabilizer). Thus, Giese actually teaches away² from extending the insert along the entire length of the shoe as called for in each of the rejected claims.

We have reviewed the additional teachings of Kendall, Crowley, Cameron and Barre but find nothing therein which would cure the above-noted deficiency of the combination of Giese in view of Tong or Giese in view of Brown and Thomas. It follows that we also shall not sustain the rejections of claim 11 as being unpatentable over Giese in view of Tong or Brown and Thomas and further in view of Kendall, claims 26-30 and 35-38 as being unpatentable over Giese in view of Tong or Brown and Thomas

² "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1331 (Fed. Cir. 1994)

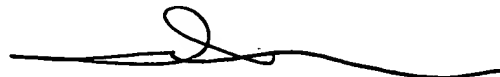
and further in view of Crowley and claims 30 and 31 as being unpatentable over Giese in view of Tong or Brown and Thomas and further in view of Cameron or Barre.

CONCLUSION

To summarize, the rejection of claims 26, 29 and 30 as being anticipated by Crowley is sustained and the rejection of claims 1, 4-9, 19-21, 26-29 and 35 as being anticipated by Tong is sustained as to claims 1, 4, 6-9, 19-21, 26-29 and 35 and reversed as to claim 5. The rejection of claims 26 and 29-31 as being unpatentable over Trolle in view of Barma is sustained. The rejection of claims 1, 4, 6-10, 19 and 26-29 as being unpatentable over Lorenzi is sustained as to claims 26-29 and reversed as to claims 1, 4, 6-10 and 19. The rejections of claims 1, 5, 6, 8-10, 12-23 and 39 as being unpatentable over Giese in view of Tong or in view of Brown and Thomas, claim 11 as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Kendall, claims 26-30 and 35-38 as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Crowley and claims 30 and 31 as being unpatentable over Giese in view of Tong or in view of Brown and Thomas and further in view of Crowley and Cameron or Barre are reversed. The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

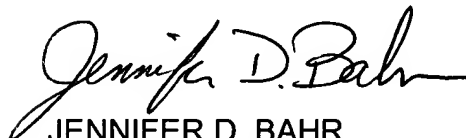
AFFIRMED-IN-PART



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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